

REMARKS

The above amendments and following remarks are submitted in response to the Official Action of the Examiner mailed January 12, 2005. Having addressed all objections and grounds of rejection, claims 1-25, being all the pending claims, are now deemed in condition for allowance. Reconsideration to that end is respectfully requested.

The Examiner has rejected claims 1-25 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Publication No. 2002/0091533, in the name of Ims et al (hereinafter referred to as "Ims"). This ground of rejection is respectfully traversed as to amended claims 1-25 for the reasons provided below.

The standard for the finding of anticipation during the examination process may be found in MPEP 2131, which states in part:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH
EVERY ELEMENT OF THE CLAIM

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The rejection of amended claims 1-25 as anticipated by Ims is respectfully traversed because "each and every element as set

forth in the claim[s] is" not "found, either expressly or inherently described" in Ims.

With regard to claim 1, the Examiner apparently finds that Workstation 10 of Figs. 1-2 corresponds to the claimed "user terminal", even though the Examiner inexplicably finds the claimed "service request generated by the user terminal" is to be found in paragraph 0072 which states on its face that it applies to the B2B system having no "user terminal" (see Fig. 3). Furthermore, the claimed "facility" which must be located in the "user terminal" is found by the Examiner at paragraphs 0095-0096 having nothing to do with workstation 10. In addition, the Examiner cites paragraphs 0051-0054 which have nothing to do with the functionality of the claimed "facility". Quite simply, the Examiner has not found in Ims, "each and every element as set forth in the claim" as required by MPEP 2131. The rejection of claim 1 is respectfully traversed.

Claim 2 depends from claim 1 and further limits the "native script" called by the "service request" generated by the "user terminal". In making his rejection, the Examiner cites paragraphs 0065-0066 and 0095-0097, which on their face address only the B2B system having no "user terminal" as claimed. The rejection of claim 2 is respectfully traversed.

Claim 3 depends from claim 2 and further limits the "service request" generated by the claimed "user terminal". In making his

rejection, the Examiner cites paragraphs 0070 and 0096-0097 again having nothing to do with a "service request" generated by a "user terminal" as claimed. The rejection of claim 3 is respectfully traversed.

Claims 4, 8, and 13 depend from claims 3, 7, and 12, respectively, and are further limited by a "repository" into which the "native script" is stored. In making his rejection, the Examiner cites paragraphs 0051-0054 which parenthetically mentions "data repository" 48 and paragraphs 0095-0096 which parenthetically mentions "script". However, it is clear that these two citations have nothing to do with each other. The claim requires storage of the "native script" in the "repository". There is not such suggestion in Ims. The rejection of claims 4, 8, and 13 is respectfully traversed.

Claims 5, 10, 15, and 19 depend from claims 4, 9, 14, and 18, respectively, and further limit the coupling network of the claimed invention. In each claim, the elements coupled to the publicly accessible digital data communication network and the transfers via that network are specifically defined. In making his rejection, the Examiner cites paragraph 0059 which parenthetically mentions the Internet without saying anything of how the system elements are coupled or what messages are transferred over it. The rejection of claims 5, 10, 15, and 19 is respectfully traversed.

Claim 6 is an independent apparatus claim having five separate element coupled together in a specific manner. In response to the first element, "publicly accessible digital data communication network", the Examiner cites paragraphs 0052-0054 which mention only privately accessible networks, LAN and WAN. Neither of these is responsive to the claim element.

The second claim element is a "database management system". The Examiner cites paragraphs 0052-0054 again which makes no mention of the claimed "database management system". The third element is an "XML message" transferred via the claimed network (i.e., claim element a). The Examiner cites paragraphs 0070 and 0097, neither of which stating that the claimed "XML" message is transferred via the claimed network.

In finding the fourth claim element within Ims, the Examiner cites paragraphs 0065-0066 and 0095-0097 which are apparently not coupled to any of the other elements found. The final claim element is a "module" which embeds "native script" into the claimed service. Though the Examiner again cites paragraphs 0070 and 0096-0097, Ims does not mention "embedding native script into a service" as claimed. Therefore, the rejection of claim 6, and all claims depending therefrom, is respectfully traversed.

Claims 7 and 14 depend from claims 6 and 13, respectively, and further limit the claimed "native script" and the "internal format" of the claimed "database management system". Ims has no

"database management system". Therefore, Ims has no "internal format" of a "database management system". Therefore, Ims cannot have these further limitations. The rejection of claims 7 and 14 is respectfully traversed.

Claim 9 depends from claim 8 and is further limited by a "response" generated by the claimed "database management system". Ims has no "database management system". Therefore, Ims cannot have the claimed "response". The rejection of claim 9 is respectfully traversed.

Claim 11 is an independent method claim having four steps. The first step requires: "transferring an XML document having a call to native script to said legacy data base management system via a publicly accessible digital data communication network". Ims has no "call to native script" within an XML document. In addition, Ims has no "legacy data base management system" coupled to a "publicly accessible digital data communication network" or otherwise.

In an attempt to find the third step, the Examiner equates the terms "embedding" and "integrating". Any competent English Language Dictionary readily distinguishes these two terms. However, perhaps more important, the step requires embedding the "native script" corresponding to the "call" from the first step. This limitation is certainly not found within the cited paragraphs 0073-0076 of Ims or elsewhere. The fourth step

requires presentation of the converted XML document to the claimed "legacy database management system" which is not found in Ims. The rejection of claim 11 is respectfully traversed.

Claim 12 depends from claim 11 and further limits the "converting" step. Having found the "converting" step to be shown in paragraphs 0096-0097 of Ims (see the rejection of claim 11), the Examiner somehow finds the further limitations of claim 12 within the unrelated paragraph 0086, which only parenthetically mentions the claimed Document Type Definition. The rejection of claim 12 is respectfully traversed.

Claim 16 is an independent apparatus claim having "means-plus-function" limitations. The first claim element is the "transmitting means". Most curiously, the Examiner cites paragraphs 0070, 0090, and 0091 of Ims which say nothing of a "publicly accessible digital data communication network".

The "providing means" requires "providing legacy data base management". Because this is not found in Ims, the Examiner cites the unrelated paragraphs 0070 and 0102 which are unrelated to the claim element. Ims also does not show the "embedding means". It has no "call to native script" and has no "legacy data base management system". The rejection of claim 16 is respectfully traversed.

Claim 17 depends from claim 16 and further limits the "providing means" wherein the "providing means" is not found in

Ims, as explained above. In support of his clearly erroneous findings, the Examiner cites paragraphs 0070 and 0102 having nothing to do with the "providing means" or the further limitations of claim 17. The rejection of claim 17 is respectfully traversed.

Claim 18 depends from claim 17 and is further limited by a "defining means for defining the native service". Because this limitation is not found in Ims, the Examiner confusingly cites paragraph 0096. The rejection of claim 18 is respectfully traversed.

Claim 20 depends from claim 19 (and therefore from claim 18) is further limited by "storing means" for storing the "defining means" of claim 18. Though the Examiner somehow found the "defining means" in paragraph 0096 of Ims, he has clearly erroneously found the "storing means" in paragraphs 0074-0077. The rejection of claim 20 is respectfully traversed.

Claim 21 is an independent apparatus claim having three basic elements. Ims has none of these elements. The first element is a "user terminal" which makes an XML data processing service request and receives a corresponding response. In making his rejection, the Examiner cites paragraphs 0065-0067 of Ims. Nowhere in this extensive citation is there a "user terminal", because it is concerned with Business to Business (B2B) transactions (see Fig. 3). Having not addresses a "user

terminal", the citation says nothing of the "data processing service request" or "response".

The third claim element is a "legacy database management system". Such an element is mention nowhere within Ims. The rejection of claim 21 is respectfully traversed.

Claim 22 depends from claim 21 and further limits the "legacy database management system" not found within Ims to include a "mainframe computer". In making his rejection, the Examiner cites paragraphs 0051-0054 of Ims which parenthetically mentions "mainframe computers or servers". However, because Ims does not have the "legacy database management system", it cannot have the limitations of claim 22. The rejection of claim 22 is respectfully traversed.

Claim 23 depends from claim 22 and further limits the software architecture of the "user terminal" to that of an "industry standard personal computer". In making his rejection, the Examiner cites paragraph 0050 of Ims which describes the hardware architecture of a computer but says nothing of the software architecture. The rejection of claim 23 is respectfully traversed.

Claim 24 depends from claim 23 and further limits the claimed "legacy database management system". Because Ims does not have this element, it cannot have the further limitations of claim 24. The rejection of claim 24 is respectfully traversed.

Claim 25 depends from claim 24 and further limits the claimed "data processing response". Because Ims does not have this element, it cannot have the further limitations of claim 25. The rejection of claim 25 is respectfully traversed.

Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this amendment and allowance of claims 1-25, being the only pending claims.

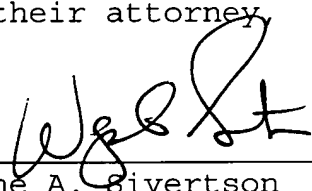
Please charge any deficiencies or credit any overpayment to Deposit Account No. 14-0620.

Respectfully submitted,

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By their attorney,

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